

## **REMARKS**

The above amendments and these remarks are responsive to the Office action dated December 23, 2003. Claims 1-22 are pending in the application. In the Office action, the Examiner rejected all of the pending claims, except claims 7 and 9, under 35 U.S.C. § 102(e). Applicants traverse these rejections, contending that the rejected claims are not anticipated. Nevertheless, to reduce the number of issues under consideration, and to expedite the issuance of a patent, applicants have (1) canceled the pending claims, without prejudice, reserving their right to pursue these claims, with or without amendment, in the future, and (2) added new claims 23-44 to more particularly point out and distinctly claim aspects of the invention recited in the "allowable" claims. In view of the above amendments and these remarks, applicants respectfully request consideration of the new claims, and prompt issuance of a Notice of Allowance.

### ***I. Claim Objections***

The Examiner objected to claims 4 and 5 under 37 C.F.R. § 1.75(c), stating that these claims were of improper dependent form for failing to further limit the subject matter of a previous claim. In particular, the Examiner asserted that the claims place limitations on elements that are not part of the apparatus. Applicants disagree. Claim 1 recites, in part, "a first stacking station designed to hold a plurality of sample holders in a first stack," and "a singulation mechanism capable of automatically adding and subtracting sample holders to and from the first stack." Claims 4 and 5 recite that these sample holders are microplates and biochips, respectively. Therefore, claims 4 and 5 are further limiting elements of the claimed apparatus, particularly the first stacking

station and the singulation mechanism, by reciting the type of sample holders that the first stacking station is designed to hold and that the singulation mechanism is capable of adding and subtracting. Nevertheless, to reduce the number of issues under consideration, and to expedite the issuance of a patent, applicants have canceled claims 4 and 5, without prejudice, rendering the rejections moot. Applicants reserve their right to pursue the canceled claims, with or without amendment, in the future.

***II. Rejections under 35 U.S.C. § 102***

The Examiner rejected claims 1-6, 8, and 10-22 under 35 U.S.C. § 102(e) as being anticipated by Kercso et al. (U.S. Patent No. 6,495,369), Stylli et al. (U.S. Patent No. 6,472,218), Modlin et al. (U.S. Patent No. 6,469,311), and/or Shtrahman et al. (U.S. Patent No. 6,402,837). Applicants traverse these rejections. In particular, applicants do not believe that these references teach or suggest all of the limitations in the rejected claims. Nevertheless, to reduce the number of issues under consideration, and to expedite the issuance of a patent, applicants have canceled the rejected claims, without prejudice, and added new claims based on dependent claims that the Examiner indicated were allowable. Applicants reserve their right to pursue the canceled claims, with or without amendment, in the future.

***III. Allowable Subject Matter***

The Examiner stated that claims 7 and 9 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **IV. Claim Amendments**

Applicants have canceled pending claims 1-22, without prejudice, and added new claims 23-44, for reasons discussed above.

The new claims include four independent claims (23, 31, 39, and 42), and eighteen dependent claims that depend therefrom, which more particularly point out and distinctly claim aspects of the invention that the Examiner indicated were allowable. Specifically, claim 23 is a rewrite of claims 7 and 1 (indicated allowable), claim 31 is a rewrite of claims 9 and 1 (indicated allowable), claim 39 is a rewrite of claims 9 and 17 (related to claims indicated allowable), and claim 42 is a rewrite of claims 9 and 20 (related to claims indicated allowable). Applicants agree with the Examiner's conclusions regarding patentability of the allowable claims, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, applicants believe that claims 7 and 9 are allowable because the prior art fails to teach or suggest all of the limitations recited in these claims.

Exemplary support for the new claims is shown, without limitation, in the following table:

<b>New Claim</b>	<b>Original Claim</b>
23 (Independent)	7+1
24	2
25	3
26	4
27	5
28	11
29	13
30	15
31 (Independent)	9+1
32	2
33	3

<b>New Claim</b>	<b>Original Claim</b>
34	4
35	5
36	11
37	13
38	15
39 (Independent)	9+17
40	18
41	19
42 (Independent)	9+20
43	21
44	22

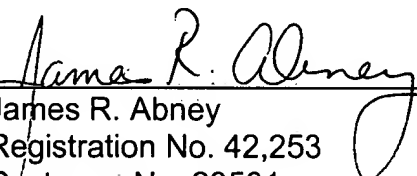


**Conclusion**

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

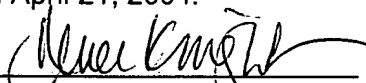
Respectfully submitted,

KOLISCH HARTWELL, P.C.

  
James R. Abney  
Registration No. 42,253  
Customer No. 23581  
Attorney for Assignee  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 21, 2004.

  
Renee Knight